

## REMARKS

Applicants thank the Examiner for the courtesies extended to the undersigned during an Interview conducted on March 14, 2007. In the Office Action mailed February 20, 2007, the Examiner rejected claims 52-55. By way of the foregoing amendments and the markings to show changes, Applicants have amended claims 32, 34 and 45, canceled claim 33 and added new claim 56. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art.

### I. Claim Rejections under 35 USC 112

The Office Action rejected claim 54 as being indefinite. Without acquiescing in the rejection, Claim 54 has been revised to address this rejection.

### II. Claim Rejections under 35 USC 103

The Office Action rejected claims 32-38 and 41-42 under 35 USC 103 as being obvious and unpatentable over a 1995 MY Chrysler JA publication (hereinafter simply referred to as Chrysler) in view of one or more of Wycech (US 6,270,600), Bryant et al. (US 3,872,548), Ligon et al. (US 5,358,397), Czaplicki (US 6,358,584), Czaplicki (US 6,263,635), Barz et al (US 6,467,834), Fitzgerald et al. (US 2002/0074827), Jansen et al (US 5,591,386) and Hanley (US 5,266,133). Applicants traversed these rejections in Response to previous Actions and the arguments of those traversals are incorporated herein by reference. During the Interview, Examiner Yao suggested that he would give strong consideration to advantages that are not obviated by the prior art. Thus, Applicants request that Examiner Yao consider the following.

During the Interview, Applicants suggested that extrusion of the expandable material directly onto the door beam, upon subsequent expansion of the expandable material, provides an unexpectedly desirable connection between the door beam and the

exterior panel structure. In particular, to establish the connection between the beam and the panel structure, the expandable material is inherently required to expand across a cavity between the beam and the panel structure without any vertical support (i.e., the expandable material is required to “jump or bridge a gap” between the beam and the panel structure). There is no suggestion in the prior art that the bonding of the expandable material to the beam will provide any significant degree of better support to the expandable material, during expansion thereof, than the mechanical fasteners used in Chrysler. However, Applicants have found that such bonding provides a very significant degree of support to the expandable material relative to an expandable material that has been attached to the beam with fasteners.

With reference to Exhibit A (included herewith), pictures 1 and 2 show results of tests performed in which a strip of expandable material has been attached to a door beam with fasteners and then expanded to “jump a gap” between the beam and a panel (see examples labeled A). The pictures also show results of tests performed in which a strip of expandable material has been extruded directly onto a door beam and then expanded to “jump a gap” between the beam and the panel (see examples labeled B). In each instance, the beams were positioned relative to the panels in a substantially identical manner. As can be seen, when the fasteners are employed, the expandable material, during expansion thereof, tends to sag and inconsistently adhere to the panel, the beam or both (sagging locations being labeled C). In contrast, when direct extrusion is employed, the expandable material, during expansion thereof, does not significantly sag and adheres to the panel in a much more consistent manner along the strip of expandable material. This ability to resist sag and adhere in a consistent manner provides for a more robust connection between the beam and the panel for performing the desired damping function recited in the claims.

In addition to the above, there is also no suggestion in the prior art to believe extrusion of the expandable material directly onto the beam would provide a bond between the material and the beam that is of sufficient strength to withstand

transportation and assembly conditions that are presented for the beams. However, Applicants have found that the bond does, in fact, provide a desirable bond for these purposes.

It should be understood that, prior to the creation of the present invention, extrusion of a strip of expandable material followed by mechanical fastening of that strip to a door beam was believed to be the most efficient and effective technique for providing such a strip to the beam. This was the case in at least those situations where the expandable material was not a pumpable and where the door beam needed to be transported after application of the strip to the beam. Moreover, it should be understood that multiple industrial existing facts at the time of the present invention suggested that extrusion directly onto the beams may not be a successful application technique. As one example, there was no particular evidence to suggest that the expandable material would be able to “jump the gap” between the door beam and the door panel, as discussed above. As another example, the door beams often tend to be oily or dirty suggesting that it would be difficult to attain a desired amount of adhesion to the beams through direct extrusion as opposed to the amount of attachment achieved with mechanical fasteners. As another example, any attempt to extrude directly onto the door beams was believed to require a relatively high capital investment since automation of such a process is typically expensive. Given these facts and beliefs, the prior art and the knowledge of the skilled artisan do not provide a motivation to develop the methodology claimed in the present application.

This is particularly the case where, as here, the motivation identified by the Office Action is not industrially significant or at least ignores the realities of extruding directly onto a door beam. The Office Action asserts that it would have been obvious to combine Ligon with Chrysler in order “to not only controllably and precisely extrude (in-line) an expandable resin to an automotive beam, but also enhance the production efficiency as well as reduce the production cost by obviating the need for fasteners and the need to separately manufacture EVDMs, while imparting ‘excellent strength and stiffness

characteristics to the beam of Chrysler.” Applicants contend that this motivation ignores the realities that existed at the time of creation of the present invention. At that time, it was not at all clear that automated extrusion onto the door beam would drive down costs since it could have just as easily been the case that reliably extruding the expandable material directly onto the door beam could have required additional physical labor or otherwise (e.g., significant cleaning and positioning of the beams) in preparation of the beams for receipt of the material. Moreover, as discussed above with the issue of “jumping the gap” between the beam and the door, it was quite unclear that extrusion directly onto the beam would produce a desirable connection between the beam and the door. Moreover, with respect to the Office Action cited motivation that the claimed methodology would impart strength to the door beam, it should be understood that the claims are directed to vibration dampening and that any strength imparted to the beam would be incidental to the vibration dampening of the panel structure and not a motivation to combine Ligon with Chrysler.

There are also additional advantages that have been realized by extrusion directly onto the door beam. First, the beam does not require openings for receipt of fasteners such that the beam retains greater structural integrity. Second, since the expandable material is not typically expanded until after vehicle e-coat, extrusion directly onto the beam can avoid some interference that might otherwise be caused by e-coat locating itself between the beam and the expandable material.

Base upon the above, Applicants request that the claims of the present application be allowed.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants intend to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of

inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

### **PETITION FOR EXTENSION OF TIME**

Applicants respectfully request and petition an appropriate extension of time to respond to the outstanding Office Action, of at least one (1) month. Enclosed is a check in the amount of \$60.00. For any deficiencies, please charge Deposit Account No. 50-1097 for any fee which may be due is hereby given.

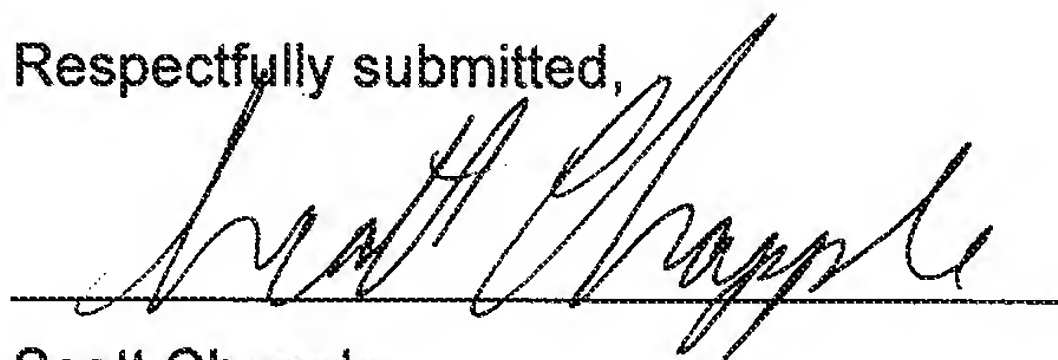
### **CONCLUSIONS**

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicant has not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge our Deposit Account No. 50-1097 for any fee which may be due.

Dated: 6 June, 2007

Respectfully submitted,



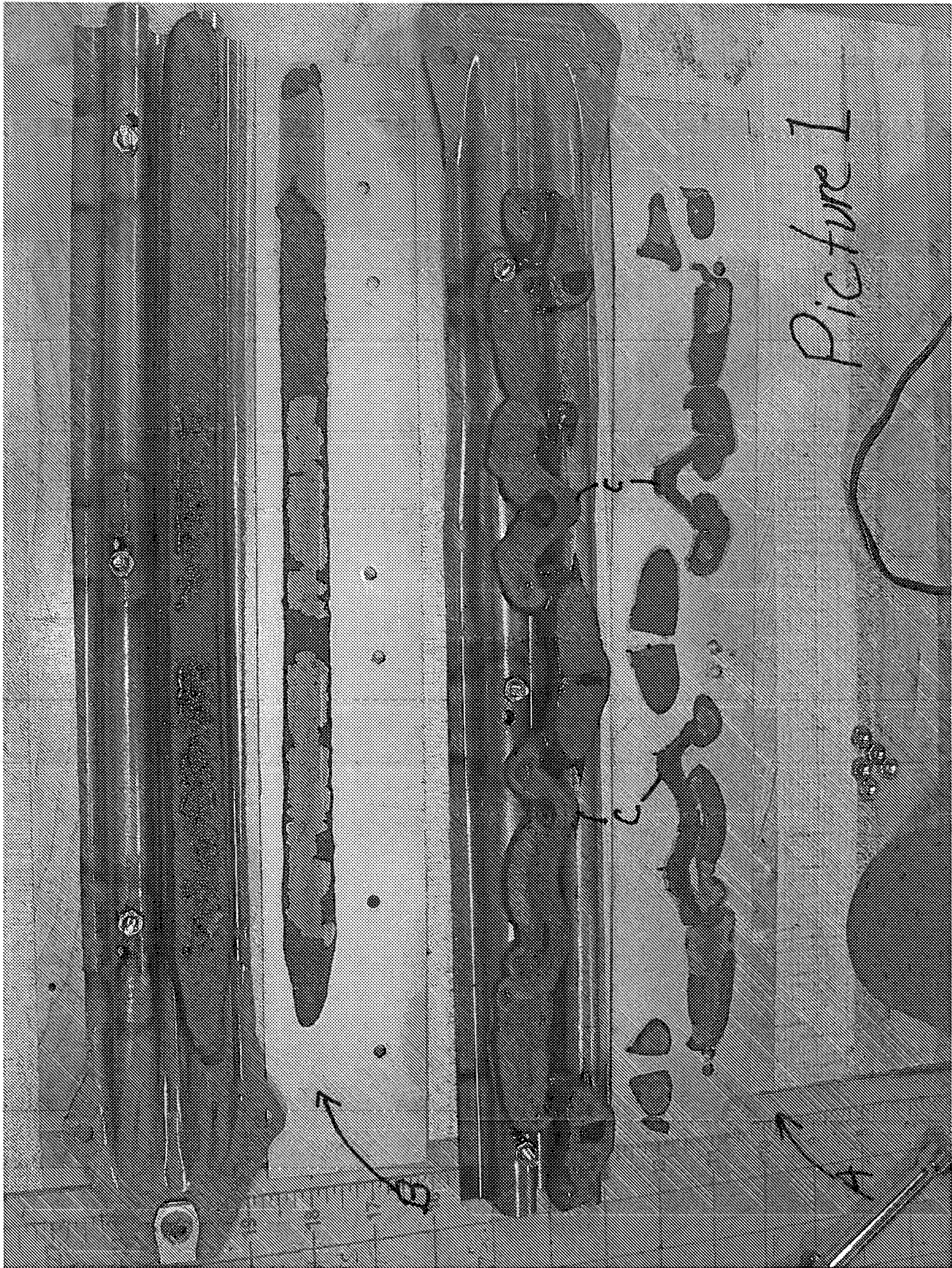
Scott Chapple  
Registration No. 46,287  
DOBRUSIN & THENNISCH PC  
29 W. Lawrence Street  
Suite 210  
Pontiac, MI 48342  
(248) 292-2920

Customer No. 25215

# EXHIBIT A



Picture 1





B

A

Picture 2